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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/201,228	11/30/1998	REMY GRIFFAIS	9710-004	1303

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EXAMINER
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MARSCHEL, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/201,228

**Applicant(s)**

GRIFFAIS ET AL.

**Examiner**

Ardin Marschel

**Art Unit**

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003 and 02 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 8-62 is/are pending in the application.
- 4a) Of the above claim(s) 17-29, 31-50 and 53-56 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57 and 58 is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-16, 30, 51, 52, and 59-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 and 8-62 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/9/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' arguments, filed 5/9/03 and 9/2/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### **TITLE**

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. A new title is again required because the present title includes both nucleic acids and uses thereof whereas in contrast the presently elected claims which are under examination are directed to isolated polynucleotides, recombinant vectors, genetically engineered host cells, DNA chips, and kits containing such polynucleotides.

### **NEW MATTER**

Claims 1-3, 8-16, 30, 51, 52, and 59-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Percent homology limitations in claims 1-3 now are directed to homology to a polypeptide sequence which then defines claimed polynucleotides. This is a two step definition of such claimed polynucleotides. It is noted that the specification as filed cites

percent homology for polynucleotides of the invention on page 9, lines 11-28, but without stating what encoded polypeptides are included as the disclosed invention. In the specification on page 17, lines 25-35, polypeptides of the invention are disclosed with various percent homologies, but without stating what polynucleotides would encode them. Neither of these disclosures contain a written description of the two step polynucleotide definition as now claimed where the polynucleotides are defined by a percent homology of possible polypeptides. This two step definition of polynucleotides therefore lacks written description as filed and is NEW MATTER. Claims which depend directly or indirectly from claims 1-3 are also included due to their dependence. This rejection is necessitated by amendment.

Claim 59, parts "k)" and "l)", have been amended into the claim to recite a polynucleotide encoding or according to claim 59(a) through 59(l) or 59(k). This encoding or according to wording is reasonably interpreted as indicating that the claimed polynucleotide is made up of a series of segments, that series being the parts (a) – (l) or (a) – (k) of claim 59. Such a conjugated polynucleotide has not been found as filed regarding written description and therefore is NEW MATTER. It is noted that claims 60-62 also all contain this conjugate NEW MATTER limitation. This rejection is necessitated by amendment.

#### **VAGUENESS AND INDEFINITENESS**

Claims 1-3, 8-16, 30, 51, 52, and 59-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is necessitated by amendment as modified by the homology percentage referring to polypeptides, but is similar to the percent homology rejection set forth regarding polynucleotides per se, as in the office action, mailed 12/3/02. The 80% homology limitation in claim 1, line 5-6, for example, has not been argued but only stated as having been responded to via amending. The 80% homology as now amended refers to homology between polypeptides and is still unclear whether the percentage is based on the polypeptide encoded by the specific sequences in the claim as 100% or whether it is based on the homologous polypeptide as 100%. This unclear percentage issue is present in claims 1-3, 8-16, 30, 51, and 52 either directly or via claims from which they directly or indirectly depend. This rejection may be overcome by amending the percentage limitations with wording such as "80% homology to the entirety of a polypeptide selected..." or equivalent limitations.

Claim 59 has been amended to include limitations regarding complementarity, such as in the phrase "polynucleotide sequence complementary to nucleotides...". Complementarity may include mismatches such that the complementarity of one polynucleotide to another may be 90%, 60%, 40%, or less. The complementarity limitations in claim 59 lack any definition of the metes and bounds of the percentage complementarity that is meant. Clarification is requested via clearer claim wording. This rejection may be overcome by amending such as potentially "fully complementary and of the same length as" or equivalent limitations. This rejection also applies to claims dependent directly or indirectly from claim 59.

In claim 59, part "k)", the phrase "polynucleotide encoding claim 59(a)..." is set forth. Applicants may have intended this claim part to be worded as 59 l), however, this is not what is presently set forth for claim 59, part "k)". Clarification is requested via clearer claim wording.

### **PRIOR ART**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 59 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Product O 4253 of the 1990 Sigma Chemical Catalog.

This rejection is necessitated by amendment of claim 59 wherein complementary sequences are required in various parts therein. As noted in the previous office action, mailed 12/3/02, all of the polypeptides, such as that of SEQ ID NOS: 1083 contain a Phenylalanine therein which is encoded by "TTT". The 100% complement to a polynucleotide containing said sequence is "AAA". Product O 4253 is a trimer of A which is "AAA" thus anticipating this complement limitation in instant claim 59.

Claims 57 and 58 are allowed.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains claims 17-29, 31-50, and 53-56, drawn to an invention nonelected without traverse as noted in the Office action, mailed 4/17/01. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.


Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

December 12, 2003

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER